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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/657,738	09/08/2000	Junji Otani	NV/P-22090/A	3187

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EXAMINER

YAMNITZKY, MARIE ROSE

ART UNIT PAPER NUMBER

1774

DATE MAILED: 01/29/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

AS-9

Office Action Summary

Application No.

09/657,738

Applicant(s)

OTANI ET AL.

Examiner

Marie R. Yamnitzky

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,7 and 12-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-3,7 and 12-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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This Office action is in response to applicants' amendment received 11/04/02 (Paper No. 8), which amends claims 1-3, 7, 12 and 13, cancels claims 4-6 and 8-11, and adds claims 14-21.

Claims 1-3, 7 and 12-21 are pending.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 12 and 19-21, drawn to an electroluminescent device, classified in class 428, subclass 690.
- II. Claims 7 and 13-17, drawn to a fluorescent diketopyrrolopyrrole, classified in class 252, subclass 301.16.
- III. Claims 2, 3 and 18, drawn to a process of making a diketopyrrolopyrrole, classified in class 548, subclass 452.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are somewhat related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because while the combination requires a diketopyrrolopyrrole, the scope of diketopyrrolopyrroles allowed for the combination is not commensurate in scope with the scope of diketopyrrolopyrroles covered by the subcombination

claims. The claims as a whole cover numerous species of diketopyrrolopyrroles. Some of the subcombination claims encompass various species outside the scope of species encompassed by the combination claims, and the combination claims encompass various species outside the scope of some of the subcombination claims (for example, compare the species encompassed by claim 1 to the species encompassed by claim 7). The disparity in scope between the diketopyrrolopyrrole required by the combination claims and the diketopyrrolopyrrole of the subcombination claims is evidence that the combination does not require the particulars of the subcombination. The subcombination has separate utility such as a fluorescent colorant in a polymeric composition.

Inventions of Group III and Group II are somewhat related as processes of making and products made. Inventions of Group III and Group I are also somewhat related as processes of making and products made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the inventions of Groups III and II are said to be somewhat related because the processes as claimed only make a portion of the products of Group II (for example, several of the specific compounds set forth in claims 13 and 14 would not result from the process of any of claims 2, 3 or 18). The inventions of Groups III and I are said to be somewhat related because the processes as claimed do not directly provide the products of Group I; rather, the processes are capable of providing a subcomponent which can be used to make the products of Group I.

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Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and the search required for each of the Groups is not coextensive, restriction for examination purposes as indicated is proper.

In addition to the preceding restriction requirement, an election of species is required. This application contains claims directed to the following patentably distinct species of the claimed invention: a diketopyrrolopyrrole of formula I or formula III wherein, for either formula, - each of Ar_1 and Ar_2 is independently selected from an aryl radical of (a) the first formula, (b) the second or third formula, (c) the fourth formula, (d) the fifth formula, (e) the sixth formula, or (f) the seventh formula wherein the first-seventh formula are the seven formulae for aryl radicals set forth on the bottom of page 1 and the top of page 2 of the specification, and - each of R_1 and R_2 is independently selected from (g) C_{1-25} alkyl, (h) allyl substituted with C_{1-3} alkyl, (i) allyl substituted with substituted or unsubstituted phenyl as described on page 1 of the specification, (j) allyl substituted with substituted or unsubstituted naphthyl as described on page 1 of the specification, or (k) $-CR_3CR_4-(CH_2)_m-Ar_3$ wherein R_3 and R_4 are independently selected from (i) hydrogen, (ii) C_{1-4} alkyl or (iii) substituted or unsubstituted phenyl as described on page 1 of the specification, Ar_3 is (iv) substituted or unsubstituted phenyl as described on page 1 of the specification or (v) substituted or unsubstituted naphthyl as described on page 1 of the specification, and m is 0, 1, 2, 3 or 4, and - and for formula III, Z is selected from (l) a single bond, (m) substituted or unsubstituted C_{2-6} alkylene as described on page 2 of the specification, (n) phenylene or (o) naphthylene.

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With respect to Ar_1 and Ar_2 , the examiner has not included the last four formulae added to the definition of Ar_1 and Ar_2 in claim 1 and some other claims by Paper No. 8 because it is not clear to the examiner that the specification as originally filed provides support for these possibilities for Ar_1 and Ar_2 . In adding these formulae to claim 1 and other claims, applicants did not state where support was provided for the amendment. If applicants are of the position that these formulae are supported as possibilities for Ar_1 and Ar_2 , they should identify support by page and line numbers, and may elect from these four formulae in addition to the seven formulae referenced above.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. In addition, applicant is required to identify an ultimate species that will be used as the starting point for further search and examination of the claims. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

No telephone call was made to request an oral election to the above restriction and election of species requirements due to the complexity of the requirements.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (703) 308-4413. The examiner works a flexible schedule but can generally be reached at this number from 6:30 a.m. to 4:00 p.m. Monday, Tuesday, Thursday and Friday, and every other Wednesday from 6:30 a.m. to 3:00 p.m.

The current fax numbers for Art Unit 1774 are (703) 872-9311 for official after final faxes and (703) 872-9310 or (703) 305-5408 for all other official faxes. (Unofficial faxes to be sent directly to examiner Yamnitzky can be sent to (703) 872-9041.)

MRY
01/27/03



MARIE YAMNITZKY
PRIMARY EXAMINER

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